

REMARKS

Claims 1-18 are pending in the present application. Applicants have amended Claims 1, 3-5, 11, 12 and 15-18 herewith. Reconsideration of the claims is respectfully requested.

Applicants would initially like to thank the Examiner for taking the time to conduct a telephonic interview with Applicants' representative on November 9, 2004. While no agreement was reached, Claim 1 was discussed and in particular Applicants' representative described how Claim 1 differed from the teachings of the cited Scott reference.

I. 35 U.S.C. § 102, Anticipation

The Examiner rejected Claims 1-2, 6-12 and 14-18 under 35 U.S.C. § 102(e) as being anticipated by Scott et al. (U.S. Patent Pub No. 2002/0000998A1). This rejection is respectfully traversed.

With respect to Claim 1, Applicants have amended such claim to clarify that the plurality of images provided within a document are *multiple different versions* of an initial image, but having different sizes. The teachings of the cited Scott reference are keen on reducing memory requirements for storing images, and accordingly maintain a *single version* of an image, with subsequent decompression and resizing (zoom-in, zoom-out) of such single image on-the-fly to present various sizes as desired by a user. This can be seen by Scott's detailed description in paragraphs 0071-0075. For example, in paragraph 0075, it states "Referring to FIG. 5A, there is shown a thumbnail size image 20 which is extracted at a first resolution from a compressed true image and displayed on a display screen". Such image extraction from a single (true) image is expressly desired by Scott to reduce memory requirements (Scott paragraph 007). There is simply no teaching of providing a plurality of alternate images within the same electronic document as the initial image, as expressly recited in Claim 1. Thus, Claim 1 is shown to not be anticipated by the cited reference.

Further with respect to Claim 1, Applicants urge that the cited reference does not teach the claimed step of "responsive to receiving user selection input, replacing the

initial image with an alternate image *and reformatting the electronic document*” (emphasis added by Applicants). In rejecting Claim 1, the Examiner states that such step is taught by Scott at Para 0096. Applicants show that there, Scott states:

[0096] Preferably, a check is made in decision block 124 to determine if a user selected containment area is to be zoomed in. If decision block 124 returns true (zoom-in), processing continues at step 125. In step 125, the selected containment area is enlarged (zoomed up) to the available display area, and this is likewise carried out for any (sub)containment areas with respect to the relevant parent containment areas. Execution then continues at step 121, where the aspect ratio zooming process is applied in steps 121 and 123.

As can be seen, this passage states that a containment area, and any associated sub-containment areas, is conditionally enlarged. There is no electronic document associated with such containment areas – only one or more images that can be selectively zoomed (in or out). Therefore, this cited passage does not establish any teaching of the claimed step of “responsive to receiving user selection input, replacing the initial image with an alternate image *and reformatting the electronic document*”. Thus, Claim 1 is further shown to not be anticipated by the cited reference.

Applicants initially traverse the rejection of Claims 2 and 6-10 for reasons given above regarding Claim 1 (of which Claims 2 and 6-10 ultimately depend upon).

Further with respect to Claim 8, such claim recites “wherein the selector comprises indicators displayed on the image”. In rejecting Claim 8, the Examiner states that this claimed feature is taught by Scott at Para 0076. Applicants urge that this passage merely describes a user clicking a mouse to instigate a zoom-in operation. There is no teaching or other suggestion of any type of indicator being displayed *on the image*, as expressly recited in Claim 8. For a prior art reference to anticipate in terms of 35 U.S.C. 102, *every element of the claimed invention must be identically shown in a single reference. In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990) (emphasis added by Applicants). As every element of the claimed invention is not identically shown in a single reference, Claim 8 is shown to have been erroneously rejected under 35 USC 102.

Further with respect to Claim 9, such claim recites “wherein clicking on the image itself provides access to alternate images”. In rejecting Claim 9, the Examiner states that

this claimed feature is taught by Scott at Para 0076. Applicants urge that this passage merely describes a user clicking a mouse to instigate a zoom-in operation. There is no teaching or other suggestion that such clicking is *on the image itself*, as expressly recited in Claim 9. As every element of the claimed invention is not identically shown in a single reference, Claim 9 is shown to have been erroneously rejected under 35 USC 102.

With respect to Claim 11, Applicants urge that the cited reference does not teach the claimed feature of “selecting an alternate image from a plurality of alternate images by means of a selector, *wherein the alternate images are explicitly referenced within the same electronic document*” (emphasis added by Applicants). In rejecting Claim 11, the Examiner states that Scott teaches this claimed feature at Para 0076, Para 0138-0139 and Figs. 4, 5A, 8, 9, 10 and 11. Applicants urge that these passages of Scott merely teach a single ‘true image’ that is decompressed and scaled (Scott paragraph 0072, 0139). There is no teaching of multiple alternate images that are explicitly referenced within the same electronic document, as expressly recited in Claim 11. Thus, Claim 11 is shown to not be anticipated by the cited reference.

Applicants initially traverse the rejection of Claims 12 and 14 for reasons given above with respect to Claim 11 (of which Claims 12 and 14 depend upon).

Further with respect to Claim 12, such claim has been amended to recite the claimed feature of “wherein the alternate images are explicitly referenced in the electronic document by an image tag contained within the electronic document”. The cited reference does not teach or suggest an image tag contained within an electronic document, and therefore does not teach or suggest that alternate images are explicitly referenced in an electronic document by such (missing) image tag. Thus, amended Claim 12 is further shown to not be anticipated by the cited reference.

With respect to Claims 15 and 17, Applicants traverse for similar reasons to those given above with respect to Claim 1.

With respect to Claims 16 and 18, Applicants traverse for similar reasons to those given above with respect to Claims 11 and 12.

Therefore, the rejection of Claims 1-2, 6-12 and 14-18 under 35 U.S.C. § 102 has been overcome.

II. 35 U.S.C. § 103, Obviousness

The Examiner rejected Claims 3-5 and 13 under 35 U.S.C. § 102 as being unpatentable over Scott et al. (U.S. Patent Pub No. 2002/0000998A1) in view of Blumberg (U.S. Patent 6,708,309). This rejection is respectfully traversed.

Applicants initially traverse the rejection of Claims 3-5 and 13 for similar reasons to those given above regarding Claim 1 with respect to the missing claimed step of providing alternate images within the same document as the initial image.

Further with respect to Claim 3, such claim has been amended to recite concurrent operations of automatically downloading an alternate image with displaying the initial image. This claimed feature advantageously provides a user with perceived data throughput enhancements (Specification page 12, lines 19-22; page 13, lines 1-6). None of the cited references teach or suggest this claimed feature. For example, the cited Blumberg reference teaches a separate image download in response to an explicit image data request command (Blumberg Col. 4, lines 19-28). Thus, Claim 3 is further shown to not be obvious in view of the cited references.

Further with respect to Claim 4, such claim has been amended to be in independent form. Applicants urge that none of the cited references teach or suggest the claimed feature of “responsive to receiving user selection input, replacing the initial image with an alternate image using a HTML/XML image tag having an alternate image attribute, wherein the alternate image attribute specifies the alternate image”. In rejecting Claim 4, the Examiner acknowledges that the cited Scott teaching is deficient regarding image tags, but cites Blumberg as mentioning “an HTML format”, citing Blumberg Col. 6, lines 1-20. Applicants urge that this Blumberg passage merely discusses server or client processing requirements when a document is not in an HTML format, and provides no teaching or suggestion of image tags, or the use of an image tag having an alternate image attribute that specifies an alternate image. Thus, the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 4¹. Accordingly,

¹ To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. See also, *In re Royka*, 490 F.2d 580 (C.C.P.A. 1974).

the burden has not shifted to Applicants to rebut obviousness². In addition, because of such failure to establish a prima facie showing of obviousness, the rejection of Claim 4 is shown to be in error³.

Therefore, the rejection of Claims 3-5 and 13 under 35 U.S.C. § 102 has been overcome.

² In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.*

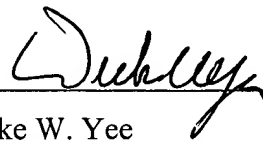
³ If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

III. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 11/23/02

Respectfully submitted,



Duke W. Yee
Reg. No. 34,285
Wayne P. Bailey
Reg. No. 34,289
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Attorneys for Applicants